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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,009	12/22/1999	JEONG S. LEE	003764.P006	5656

7590 09/25/2002

ANDREW C CHEN
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD 7TH FLOOR
LOS ANGELES, CA 90025

EXAMINER

LAM, ANN Y

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/470,009

Applicant(s)

LEE ET AL.

Examiner

Ann Y. Lam

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-26 and 39-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-26 and 39-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 11, 13, 16-18, 39, 42-45, 48-51 and 54-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Shank et al., 5,147,317, for the same reasons as set forth in Office action dated March 31, 2002.

2. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Hibbs et al., 4,950,257, for the same reasons as set forth in Office action dated March 31, 2002.

Claim Rejections - 35 USC § 103

3. Claims 11-26 and 39-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraus et al., 5,246,420, in view of Lorenzo, 5,836,892, for the same reasons as set forth in Office action dated March 31, 2002.

Response to Arguments

Applicant's arguments filed March 8, 2002 have been fully considered but they are not persuasive. Applicant argues that the guidewire disclosed in Shank is intended to lessen resistance of guidewire movement within the catheter lumen, and that nothing

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in Shank discloses a mandrel adapted to reinforce a catheter, see page 9, lines 12-16, and also pages 10-12. In response, Examiner asserts that the guidewire in Shank has the same structural limitations as claimed by Applicant and is considered to reinforce a catheter. Moreover, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant further argues that a mandrel is not equivalent to a guidewire. Applicant argues that a mandrel is part of a catheter and moves with the catheter, whereas a guidewire is independent of the catheter and does not moved with the catheter. Applicant further argues that a guidewire serves as an aid in the placement of a catheter in a selected site within a human body, whereas a mandrel is adapted to reinforce a catheter, see page 9, lines 18-23. In response, Examiner reasserts that, in the medical field, the prior art discloses 'guidewires' that are part of a catheter and moves with the catheter, and are adapted to reinforce a catheter.

As to claim 12, Applicant argues that a mandrel is not equivalent to a sheath as disclosed in Hibbs. Applicant argues that a mandrel is part of a catheter and moves with the catheter, whereas a sheath is independent of the cathete and does not move with the catheter, see page 13, lines 21-23. In response, Examiner asserts that a the

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sheath in Hibbs discloses the same structure as claimed by Applicant. Moreover, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

Applicant also argues that there is no motivation to combine Kraus with Lorenzo, and that the Office action does not explain any motivation for combining the two references, see page 15 lines 1-9. In response, Examiner asserts that the Kraus mandrel and the Lorenzo core wire are considered relevant art because both are used as a reinforcement for a medical device such as a catheter, and both have same or similar structures.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is (703) 306-5560. The examiner can normally be reached on T-F 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703)308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)306-4520 for After Final communications.

A.L. 
September 19, 2002


ANH TUAN T. NGUYEN
PRIMARY EXAMINER
